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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/611,645	06/30/2003	Hung-Jen Hsu	TSM03-0463	2071

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EXAMINER

MCPHERSON, JOHN A

ART UNIT	PAPER NUMBER
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1756

DATE MAILED: 07/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/611,645

Applicant(s)

HSU ET AL.

Examiner

John A. McPherson

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eb

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Supplemental Action

1. This Supplemental Office Action corrects an error on the Office Action Summary (form PTOL-326) mailed 7/1/04, and also modifies the rejection set forth in paragraph 4 of the Office Action mailed 7/1/04.

2. In the Office Action Summary (form PTOL-326) of the Office Action mailed 7/1/04, it was incorrectly stated that claims 1-28 are subject to restriction. This Supplemental Office Action includes a new Office Action Summary which correctly states that claims 1-28 are rejected (and not subject to restriction).

Additionally, in the previous Office Action mailed 7/1/04, a 35 USC 102 rejection was set forth over the abstract of KR 2001-010306. After the mailing of the previous office action a complete copy of this reference became available. This Supplemental Office Action replaces the rejection over the abstract with a rejection over the complete Korean publication, as set forth below in paragraph 6.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 19-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 19 recites the limitation "the photoresist filler material" in lines 7-8.

There is insufficient antecedent basis for this limitation in the claim.

Note that if antecedent basis is provided for this limitation, then claim 21 will not further limit claim 19.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7 and 19-28 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 6-302794 (JP '794). JP '794 discloses a method of manufacturing a solid-state image sensing element comprising the steps of forming a flattening layer on a substrate having a recessed bonding pad section containing an aluminum electrode, applying a photosensitive resin layer as a lens layer on the flattening layer, forming rectangular patterns by photolithography, heat flowing the rectangular patterns to form microlenses, forming a spin-on-glass layer, forming a resist layer for boring a pad window, patterning the resist layer, and etching the glass layer and the flattening layer to form a pad window. See the abstracts and Figure 1(A)-(E).

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5. Claims 9-10 and 12-17 are rejected under 35 U.S.C. 102(e) as being anticipated by US 5,426,058 (US '058). US '058 discloses a method of manufacturing a solid-state imaging device comprising the steps of smoothing the surface of a semiconductor substrate by embedding a polymeric or polymerizable material into recessed portions in the surface, forming microlenses on the substrate, and cutting the substrate along scribe lines that constitute parts of the recessed portions. See the abstract and column 3, line 42 to column 4, line 68.

6. Claims 1-18 are rejected under 35 U.S.C. 102(b) as being anticipated by KR 2001-0010306 (KR '306). KR '306 discloses a method of making a charge coupled device having microlenses comprising the steps of forming a first planarized layer on a semiconductor substrate, forming a second planarized on layer on the first planarized layer, and forming microlenses on the second planarized layer, wherein the first planarized layer and the microlenses are formed of positive photoresist. See the abstract and Figures 6-11.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John A. McPherson whose telephone number is (571) 272-1386. The examiner can normally be reached on Monday through Friday, 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on (571) 272-1385. The fax

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phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John A. McPherson
Primary Examiner
Art Unit 1756

JAM
7/6/04